

Remarks:

Objections:

The Examiner has objected to the use of the terms “of” and “for” without providing any support whether in reason, statute or case law. The Applicant respectfully requests that the objections to be withdrawn in the absence of the same.

§103 Rejections:

Claims 1-15 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ketcham (US 6,075,860) in view of in view of Chan (US 5,970,144) and in further view of Kaliski (US 6,085,320). Applicant respectfully traverses the rejection.

MPEP §2143 provides: “To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

Claim 1, as amended, recites a secured communication method for a mobile communications network comprising: “receiving a request to provide a security key to a mobile device connected to the mobile communications network; generating a unique security key for the requesting mobile device in response to receiving a unique identification number from the mobile device; storing the unique security key in a first data storage mechanism in association with the unique identification number identifying the mobile device, wherein the first data storage mechanism is accessible to a server system connected to the mobile device over a wide area communicatoin network, and wherein the first data storage mechanism is not directly accessible by the mobile device; receiving a request to provide the unique security key for the mobile device to a service

provider such that the service provider can provide a service to the mobile device based on the unique security key; and approving the request to provide the unique security key to the service provider based on content of a list of service providers stored in a second data storage mechanism, wherein the second data storage mechanism is directly accessible by the mobile device, wherein the content of the list of service providers is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device.”

Ketcham fails to disclose all the elements of claim 1. Ketcham discloses a method and system for authenticating an authorized user of a remote terminal attempting to connect with a computer network over a wireless modem. The network server and remote terminal exchange encrypted information to authenticate each party. Both the remote terminal and the network server independently generate a data encryption key [see Abstract.] The remote terminal does not retain the user identifier or the authentication encryption key. Instead, an authentication card personal to the authorized user is maintained by the authorized user [see column 3, lines 61-64].

Ketcham also discloses an authentication database for receiving and storing the user identifier and the authentication encryption key [column 7, lines 17-19] and an account generator that comprises a key generator receptive to an authorization request for generation of a cryptographically suitable authentication encryption key [column 6, lines 48-52]. Ketcham’s system is, however, patentably distinguishable from that claimed herein.

In particular, as admitted by the Examiner, Ketcham fails to disclose any of the following elements (1) receiving a request to provide the unique security key for the mobile device to a service provider; (2) approving the request to provide the unique security key based on content of a list of service providers, generating a unique security key for the requesting mobile device in response to receiving a unique identification

number from the mobile device; (3) storing the unique security key in a first data storage mechanism in association with the unique identification number identifying the mobile device, (4) wherein the first data storage mechanism is accessible to a server system connected to the mobile device over a wide area communication network, and (5) wherein the first data storage mechanism is not directly accessible by the mobile device; (6) receiving a request to provide the unique security key for the mobile device to a service provider such that the service provider can provide a service to the mobile device based on the unique security key; and (7) approving the request to provide the unique security key to the service provider based on content of a list of service providers stored in a second data storage mechanism, (8) wherein the second data storage mechanism is directly accessible by the mobile device, (9) wherein the content of the list of service providers is editable by a user of the mobile device by way of directly accessing the second data storage mechanism via the mobile device.

The Examiner contends that Chan and Kaliski can be combined with Ketcham in the direction of the claimed invention. The Applicant has carefully reviewed the two secondary references and respectfully submits that neither reference cures the deficiencies of Ketcham. The Examiner is requested to point out the recited elements 1 through 9 above in amended claim 1 with specificity or otherwise withdraw the 103 grounds of rejection.

Chan discloses a system and method for enabling sensitive authentication information (e.g. the authentication key) to be under the control of the service provider and for transmitting only non-sensitive authentication information in order to prevent the signal transmitted between the mobile stations and the base stations to be intercepted by an unauthorized source. Chan further discloses a system and method for generating sensitive authentication information for securely transmitting to and storing the information in the mobile stations and in storage device controlled by the security system.

Chan, however, fails to disclose the above enumerated elements either alone or in combination with the other cited references.

Kaliski discloses a protocol for establishing the authenticity of a client to a server in an electronic transaction by encrypting a certificate with a key known only to the client and server. The client generates and sends over a communication channel a message containing at least a part of a certificate encrypted with the server's public key. The server receives and processes the message to recover at least part of the certificate. The server verifies and accepts the message as proof of the client authenticity. Kaliski, however, fails to disclose the above enumerated elements either alone or in combination with the other cited references.

It is respectfully submitted that the references either alone or in combination fail to teach or suggest the elements of claim 1. While the suggestion to modify or combine references may come from the knowledge and common sense of a person of ordinary skill in the art, the fact that such knowledge may have been within the province of the ordinary artisan does not in and of itself make it so, absent clear and convincing evidence of such knowledge. *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 U.S.P.Q.2d 1225, 1232 (Fed. Cir. 1998).

Here, the modification or combination proposed by the Examiner is not based on any clear and convincing evidence of a reason, suggestion, or motivation in the prior art that would have led one of ordinary skill in the art to combine the references. Rather, the reason, suggestion and motivation for the combination of references proposed by the Examiner simply is impermissible hindsight reconstruction given the benefit of Applicant's disclosure.

The Federal Circuit has consistently held that hindsight reconstruction does not constitute a prima facie case of obviousness under 35 U.S.C. § 103. *In re Geiger*, 2

USPQ2d 1276 (Fed Cir. 1987). Unfortunately, the Examiner rather than pointing to what the prior art discloses and teaches as to making the suggested modification relies on assumptions and statements without any support in the record. As such, the Examiner's statements regarding obviousness and motivation to modify are but shortcuts to a conclusion of obviousness devoid of the required analytical approach based on what is actually disclosed in the prior art.

Reliance on impermissible hindsight to avoid express limitations in the claims and setting forth unsupported hypothetical teachings to recreate the Applicant's claimed invention cannot establish a prima facie case of obviousness. Since obviousness may not be established by hindsight reconstruction, the Applicant invites the Examiner to point out the alleged motivation to combine with specificity,¹ or alternatively provide a reference or affidavit in support thereof, pursuant to MPEP §2144.03.²

Since no reasonable justification is provided in the Office Action as to how such modification or combination is possible and obviousness may not be established based on hindsight and conjecture, it is respectfully requested that the 103 grounds of rejection be withdrawn.

For the above reasons, neither of the references, either alone or in combination, teach or suggest the invention as recited in claim 1. Therefore, it is respectfully submitted that claim 1 is in condition for allowance. The remaining claims either depend on claim 1 or substantially incorporate same or similar elements and should be in condition for allowance.

1 *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984).

2 "The rationale supporting an obviousness rejection may be based on common knowledge in the art or "well-known" prior art . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position. When a rejection is based on facts within the personal knowledge of the examiner . . . the facts must be supported, when called for by the applicant, by an affidavit from the examiner."

No amendment made was related to the statutory requirements of patentability unless expressly stated herein; and no amendment made was for the purpose of narrowing the scope of any claim, unless Applicants have expressly argued herein that such amendment was made to distinguish over a particular reference or combination of references.

If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (310) 789-2100 to discuss the steps necessary for placing the application in condition for allowance.

Respectfully submitted,

/F. Jason Far-hadian/

Date: July 28, 2008

By: _____
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